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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### **DETAILED ACTION**

Receipt of Amendments/Remarks filed on April 14 2010 is acknowledged.

Claims 13 and 18 were/stand cancelled. Claims 1, 6-12 and 16-17 were amended.

Claims 1-12 and 14-17 are pending.

Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The rejection of claims 1-18 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is **withdrawn** in light of Applicants' amendments filed on April 14 2010.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Modified Rejection Based on amendments in the reply filed on April 14 2010**

**Claims 1-12 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bujard et al. in view of Deluca et al. (WO 0216505).**

***Applicant Claims***

The instant application claims a cosmetic and personal care preparation comprising (a) from 0.0001 to 90% by weight of a gloss pigment comprising (a1) a core consisting of a transparent or metallically reflecting material and (a2) at least one coating consisting of one or more silicon oxide, the molar ratio of oxygen to silicon being on average from 0.03 to 0.95 and (b) from 10 to 99.9999% of a cosmetically suitable carrier material based on the total weight of the cosmetic preparation or formulation wherein said formulation or preparation is selected from the group consisting of lipsticks, blushers, foundations, nail varnishes and hair shampoos.

**Determination of the Scope and Content of the Prior Art  
(MPEP §2141.01)**

Bujard et al. teach a colored luster pigments comprising a core consisting of a substantially transparent or metallic reflecting material and at least one coating consisting essentially of one of more silicon oxides having a molar ratio of oxygen to silicon being from 0.25 to 0.95 (col. 2, line 62 to col. 3, line 2). Column 3, lines 31-46 teach examples of the core material such as Si and Ti. Column 4, lines 8-9 teach that the pigments can further comprise an additional coating which is different from the first; lines 26-29 teach examples of the metal oxides and mixtures thereof that can be employed in the second coating; finally line 34-35 teach that the arrangement of coatings relative to the core may be in any order. Column 8, lines 28-30 teach that high molecular weight organic materials can be used with the pigments. When utilized they are used in amount from 0.1 to 30% by weight (column 9, lines 23-31). It is taught that

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the ratio of silicon to oxygen can be precisely controlled by adjusting the oxygen partial pressure (column 6, lines 57-65). The colorations obtained have excellent properties such as high brightness and excellent fastness properties (column 10, lines 29-34).

**Ascertainment of the Difference Between Scope the Prior Art and the Claims  
(MPEP §2141.012)**

While Bujard et al. teach the same core and coatings, Bujard et al. do not exemplify the claimed pigments.

Bujard et al. do not teach utilizing the pigments in cosmetic or personal care composition. However, this deficiency is cured Deluca et al.

Deluca et al. is directed to colored lustrous pigments. The pigments are metal oxide coated mica (page 3, lines 15-18). The metal oxide coatings include titanium dioxide, zirconium dioxide and iron oxide (page 4, lines 4-6). Depending on the thickness of the coating, the pigments can exhibit interferences or reflection colors of blue, green, yellow, red, etc. (column 4, lines 14-16). Exemplified particles are titanium dioxide coated mica. The pigments are utilized in cosmetic products such as lipsticks, eye shadow, cream eye shadow and lotions (page 8). Exemplified amounts of colorants utilized in cosmetics include 15, 45, 20, and 5%.

***Finding of Prima Facie Obviousness Rationale and Motivation***  
**(MPEP §2142-2143)**

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to combine the teachings of Bujard et al. and Deluca et al. and

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manipulate the coating material and utilize a variety of different coating materials in varying order. One of ordinary skill in the art would have been motivated to vary the coating material and utilize different coating material in various order as Bujard et al. teach that the arrangement of the coatings relative to the core may be in any order.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to combine the teachings of Bujard et al. and Deluca et al. and utilize the colored luster pigments of Bujard et al. in a cosmetic formulation. One of ordinary skill in the art would have been motivated to utilize these pigments in cosmetic formulations as Deluca et al. teach similar colored luster pigments are known to be utilized in cosmetic formulations for adding color. Since Bujard et al. teach adding the pigments to products for adding color, it would have been obvious to one of ordinary skill in the art to add the pigments to cosmetic formulations for adding color to the composition. One of ordinary skill in the art would have a reasonable expectation of success as Deluca et al. teach metal oxide coated pigments wherein the core is mica and Bujard et al. teach metal oxide coated pigments wherein the core can be mica. Therefore, the substantially similar colored luster pigments of Bujard et al. would be expected to color cosmetic formulations based on the teachings of Deluca et al.

Regarding the claimed molar ratio of oxygen to silicon, the examiner directs applicants' attention to **MPEP 2144.05**. "Generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not

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inventive to discover the optimum or workable ranges by routine experimentation.” In *re* Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955) (Claimed process which was performed at a temperature between 40°C and 80°C and an acid concentration between 25% and 70% was held to be prima facie obvious over a reference process which differed from the claims only in that the reference process was performed at a temperature of 100°C and an acid concentration of 10%.); see also *Peterson*, 315 F.3d at 1330, 65 USPQ2d at 1382 (“The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages.”); In *re* Hoeschele, 406 F.2d 1403, 160 USPQ 809 (CCPA 1969) (Claimed elastomeric polyurethanes which fell within the broad scope of the references were held to be unpatentable thereover because, among other reasons, there was no evidence of the criticality of the claimed ranges of molecular weight or molar proportions.). For more recent cases applying this principle, see *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989); In *re* Kulling, 897 F.2d 1147, 14 USPQ2d 1056 (Fed. Cir. 1990); and In *re* Geisler, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997).” Based on the teachings of Bujard et al., one of ordinary skill in the art would know how to manipulate the oxygen and silicon ratio by adjusting the oxygen partial pressure.

Absent any evidence to the contrary, and based upon the teachings of the prior art, there would have been a reasonable expectation of success in practicing the



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instantly claimed invention. Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

### ***Response to Arguments***

Applicants argue that (1) Bujard does not teach the use of the pigments in cosmetics or personal care composition. To cure this deficiency the examiner relies on Deluca however, Deluca is directed to colored lustrous pigments. It is argued that the pigments of Deluca are different than those instantly claimed. Applicants argue that (2) the pigments of Deluca are different than the instant pigments. The instant pigments allow for an effect pigment without an titanium at all.

Applicants' arguments filed April 14 2010 have been fully considered but they are not persuasive.

Regarding applicants' first argument, the question is whether it would have been obvious to one of ordinary skill in the art to utilize the pigments of Bujard in a cosmetic or personal care composition. The examiner maintains a *prima facie* case obviousness has been made. Both Bujard and Deluca are directed to colored luster pigments. Therefore, Deluca teaches to one of ordinary skill in the art that these types of pigments (colored luster pigments) are known to be utilized in cosmetic preparations. Since the pigments of Bujard are designed to impart highly saturated and bright colors under all visual angles, their use in cosmetics would be advantageous. While, Deluca may teach different pigments, the question is would those of Bujard be obvious to use in a cosmetic. Bujard teach that the pigments can be used in paints. Deluca teach that

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colored luster pigments can be used in paints and cosmetics. The examiner maintains that they would be since colored luster pigments are known to be used in both paints and cosmetic formulations.

Regarding applicants' second argument, the examiner does not understand why applicants are arguing that their compositions do not contain titanium. The instant claims recite that the core can be of titanium as well as layers include titanium oxide. Therefore, this argument is not commensurate in scope with the claims as titanium is clearly included in the instantly claimed composition. However, even if titanium oxide were not present, the question is would one of ordinary skill in the art be motivated to incorporate the pigments of Bujard in a cosmetic formulation. Since both Bujard and Deluca are directed to composition containing colored luster pigments, the examiner maintains the use of the pigments of Bujard in a cosmetic would have been obvious.

Therefore, the rejection is maintained since applicant has not provided any persuasive arguments to overcome the rejection.

### ***Conclusion***

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ABIGAIL FISHER whose telephone number is (571)270-3502. The examiner can normally be reached on M-Th 9am-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Abigail Fisher  
Examiner  
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